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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,876	03/30/2001	Didier Wilhelm	2000FR303	6765

25255 7590 05/27/2003

CLARIANT CORPORATION
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EXAMINER

BERMAN, SUSAN W

ART UNIT PAPER NUMBER

1711

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/821,876

Applicant(s)

WILHELM ET AL.

Examiner

Susan W Berman

Art Unit

1711

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached page(s).
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-16.

Claim(s) withdrawn from consideration: _____

6. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Susan W Berman
Primary Examiner
Art Unit: 1711

Continuation of 3. Applicant's reply has overcome the following rejection(s): r jection under 35 USC 103(a) over US 6,136,912 in view o Swofford.

Detailed Advisory Action

Applicant argues that one of ordinary skill in the art at the time of the invention would not assume that the multifunctional acrylate that works in the system containing up to 35 wt. % volatile organic solvent, as taught by Swofford, would work in the solvent system disclosed by Jacquinot et al. This argument is not found persuasive for the following reasons. Jacquinot et al teach compositions comprising substantial amounts of isopropanol, the same lower alkanol solvent that Swofford employs in the examples. Swofford uses lower amounts of alkanol solvent than Jacquinot et al. Swofford does not mention the residual wt. % water in the disclosed compositions. Example I discloses heating a mixture of vinyltrimethoxysilane and Nalco colloidal silica, then adding a triacrylate, isopropanol and a photoinitiator. A low residual water content would be expected after hydrolysis of the trimethoxysilane and colloidal silica. The composition is dried at 75 °C and then irradiated to crosslink. In any case, Jacquinot et al is relied upon for teaching a very low residual water content. Since each of Jacquinot et al and Swofford teach compositions comprising a multifunctional acrylate and an alkanol solvent (such as isopropanol), applicant's argument that the multifunctional acrylate taught by Swofford would not be expected to work in the solvent system taught by Jacquinot et al is not found persuasive.

The Declaration under 37 CFR 1.130 to disqualify the commonly owned US Patent as prior art and the Statement under 37 CFR 3.73(b) establishing the right of Assignee to take action are considered sufficient to remove Jacquinot et al US 6,136,912 as a prior art reference. However, the rejections of record over JP 11-246789, FR 2 772 777 or EP 0 926 170 A1 to Jacquinot et al, each in view of Swofford, are maintained.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman
Primary Examiner
Art Unit 1711

SB
May 22, 2003